

Notice of Allowability

Application No.

10/758,972

Examiner

Vickey Nerangis

Applicant(s)

STOFFER ET AL.

Art Unit

1796

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the amendment filed on 2/22/2010.
2. ☒ The allowed claim(s) is/are 1-8,10,12-14,16-31,35,39-41,43-59,61,62,67,68,70,121,122,132,133,139,143-145,147-151,160-166,168,184,186 and 187.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
Identifying Indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 10/22/09
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 20100309A
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

Election/Restrictions

Claims 1-8, 10, 12-14, 16-22, 30, 31, 35, 39-41, 43-59, 61, 62, 67, 68, 70, 121, 122, 132, 133, 139, 143-145, 147-151, 160, 161, 164-166, 168, 184, 186, and 187 are allowable. Claims 23-29, 162, and 163, previously withdrawn from consideration as a result of a restriction requirement, contain all the limitations of an allowable claim. Pursuant to the procedures set forth in MPEP § 821.04(a), **the restriction requirement, as set forth in the Office action mailed on 7/22/2005, is hereby withdrawn** and claims 23-29, 162, and 163 hereby rejoined and fully examined for patentability under 37 CFR 1.104. In view of the withdrawal of the restriction requirement, applicant(s) are advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Examiner's Amendment

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Benjamin Armitage on 3/3/2009.

The application has been amended as follows:

In claim 23, line 1, after "claim 1" insert --wherein the solid components--.

In claim 23, line 1, replace "comprise" with --comprising--.

In claim 25, line 1, after "claim 1" insert --wherein the solid components--.

In claim 25, line 1, replace "comprise" with --comprising--.

In claim 35, line 5, replace "1%" with --1 wt%--.

In claim 35, line 5, replace "40%" with --40 wt%--.

In claim 40, line 2, replace "about 60 wt%" with --up--.

In claim 41, line 2, replace "about 60 wt%" with --up--.

In claim 43, line 2, replace "compounds" with --oxides--.

In claim 44, line 2, replace "compounds" with --oxides--.

In claim 45, line 1, replace "compound" with --oxide--.

In claim 45, line 3, replace "compounds" with --oxides--.

In claim 46, line 1, replace "compound" with --oxide--.

In claim 46, line 2, replace "compound" with --oxide--.

In claim 47, line 2, replace "compound" with --oxide--.

In claim 48, line 1, replace "compound" with --oxide--.

In claim 48, line 2, replace "compound" with --oxide--.

In claim 70, line 5, replace "1%" with --1 wt%--.

In claim 70, line 5, replace "40%" with --40 wt%--.

In claim 121, line 8, replace "1%" with --1 wt%--.

In claim 121, line 8, replace "40%" with --40 wt%--.

In claim 121, line 9, before “the rare earth oxide” insert “--solid components comprising--”.

In claim 132, line 1, replace “compound” with “--oxide--”.

In claim 132, line 2, delete “praseodymium(III) sulfate or a”.

In claim 147, line 2, replace “compounds” with “--oxides--”.

Cancel claims 154-159.

In claim 160, line 1, replace “compound” with “--oxide--”.

Cancel claim 191.

Statement of Reasons for Allowance

The present claims are allowable over the closest prior art Jung et al (WO 02/31064) and Reuter et al (US 2003/0082368) for the following reasons:

Jung et al discloses an aqueous paintlike polymer-containing, corrosion-resistant layer comprising inorganic compounds such as rare earth oxide(s) and at least one other rare compound and/or BaSO₄; a rare earth salt; a pigment such as talc; and dispersant; however, Jung et al fails to disclose or suggest the use of a mixture wherein a rare earth oxide (praseodymium oxide) is utilized in an amount of 1-40 wt % of solid components also including a substantially insoluble extender. While Reuter et al discloses extenders such as calcium and sulfate salts, it fails to disclose relative amounts that would make the presently claimed composition obvious.

Thus, it is clear that the references, taken individually or in combination, do not disclose or suggest the claimed invention.

Further, it is noted that applicant's filing of a terminal disclaimer filed on the date 3/3/2010 overcomes the double patenting rejection of record.

In light of the above, it is clear that rejections of record are untenable and thus the present claims are passed to issue.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Nerangis whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Vickey Nerangis/
Primary Examiner, Art Unit 1796